REMARKS/ARGUMENTS

In response to the Office Action mailed May 1, 2008, Applicants amend their application and request reconsideration in view of the amendments and the following remarks. In this amendment, no claims are amended, no new claims have been added and claim 22 has been cancelled without prejudice so that Claims 1–21 remain pending. No new matter has been introduced.

Claims 1, 2 and 5-10 were rejected as being unpatentable over GB200188 to Kesh in view of U.S. Patent Publication No. 2005/0033417 to Borges et al. (Borges). This rejection is respectfully traversed.

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness.

> "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art

> and not based on applicant's disclosure. In re Vaeck, 947 F.2d,488,20 USPQ2d 1438 (Fed.Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."

Section 2143.03 of the MPEP clarifies certain criteria in section 706.02(j).

> "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1074). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

Applicants acknowledge Borges contribution to the art. However, Borges qualifies as a reference under 35 USC §102(e) which according to 35 USC § 103(c)(1) is disqualified. It is respectfully submitted that Borges is a 102(e) reference and that at the time the invention was made, the reference and the claimed invention were owned by the same person as illustrated by the attached Assignments to Cordis Corporation.

Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

A favorable action on the merits is earnestly solicited.

Respectfully submitted,

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Attachments